



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,763	06/01/2001	Sean M. McCullough	VIGN1240-1	7624

25094 7590 03/01/2004

GRAY, CARY, WARE & FREIDENRICH LLP
1221 SOUTH MOPAC EXPRESSWAY
SUITE 400
AUSTIN, TX 78746-6875

EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
----------	--------------

2177

DATE MAILED: 03/01/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

09/681,763

Applicant(s)

MCCULLOUGH, SEAN M.

Examiner

Greta L. Robinson

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2&5.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 are pending in the present application.

Information Disclosure Statement

2. The information disclosure statement filed December 19, 2003 has been considered.

Drawings

3. The drawings were received on December 12, 2003. These drawings are approved.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1-18, the following limitation does not appear to be defined within the specification "**personalization rule**". Applicant does not describe what is meant by this limitation. Note page, paragraph 002, "The server may extract the personal data ... to be used with personalization rules that are a part of the personalization logic used at the web site"; but Applicant does not appear to specifically state what the personalization rules consist of or how they are implemented. Also, note the following citations with respect to personalization rules, page 4 paragraph 0002 through page 5 paragraph 0021, page 8 paragraph 0032, and page 9 paragraph 0034 and 0036.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-18, the following limitation is vague: "personalization rules" [note claims 1-18]. As stated above in paragraph 6, the meaning of the term is not clear.

Regarding claim 1, the following limitation is not clear: "sending to the client data processing system ... and receiving a second communication from the client data processing system" [note claim 1]. It is not clear as to which element or structure is "**sending**" the information and "**receiving**" the information. This argument also applies

to independent claims 6, 11 and 14 [see: claim 6 lines 1-6; claim 11 lines 1-6; and claim 14 lines 1-10].

Regarding claim 11, the following limitation is vague and unclear: "wherein, other than a network address for the user, the first communication does not include information substantially sufficient to specifically identify the user" [note claim 11 lines 3-4]. The limitation "substantially sufficient" is vague and/or unclear.

Claims 2-5, 7-10, 12-13, and 15-18 are rejected based on dependency.

Response to Arguments

8. Applicant's arguments filed December 12, 2003 have been fully considered but they are not persuasive.

In the response Applicant argued the following: Regarding the rejection under 35 USC 112 first paragraph, Applicant states "*that he is not required to provide an expressed definition for personalization rule, particularly considering personalization rules are so widely known by skilled artisans*" [see page 7 of Applicant's response filed December 12, 2003 paragraph 2]. Applicant states that personalization rules can be code within a software program for doing or not doing a specific operation. In response to Applicants remarks the examiner respectfully maintains the rejection. The examiner appreciates the amendment of figure 4 pointing out that the personalization logic information includes personalization rules; but Applicant has not shown support for what the personalization rules encompass with respect to the present inventions disclosure. Applicant appears to contrast references cited by the Examiner on form PTO-892 to the

operation of a personalization rule. Applicant must point out within the present inventions disclosure support for what is meant by the claimed limitation, note rejection *supra*. This response also applies to Applicant's remarks regarding the rejection cited under 35 USC 112 second paragraph. Applicant has not described what element is receiving a first communication from the client computer (note claim 1); or clarified how the term "substantially sufficient" (claim 11) should be measured.

Conclusion


9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GRETA ROBINSON
PRIMARY EXAMINER
Greta Robinson
Primary Examiner
February 27, 2004